

REMARKS / ARGUMENTS

The present application includes pending claims 27-53 and new claims 54-64, of which claims 27-53 have been rejected. The Applicant respectfully submits that the claims define patentable subject matter.

Claims 27-53 stand rejected under 35 U.S.C. § 112, second paragraph for allegedly failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 27, 29-34, 37, 38, and 53 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Chen et al. (Pub. No. WO 2004/016037, hereinafter Chen) in view of Addeo et al. (US Patent No. 5,335,011, hereinafter Addeo). Claim 28 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Chen in view of Addeo and further in view of Gollmar et al (U.S. Patent No. 4,901,354).

Claim 35 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Chen in view of Addeo and further in view of Butler et al (U.S. Patent No. 6,474,816). Claim 36 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Chen in view of Addeo in view of Butler and further in view of Nestorovic et al (U.S. Patent Publication No. 2004/0155186). Claims 39, 40, 42-47, and 50-52 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Chen in view of Addeo and further in view of Warren et al (U.S. Patent No. 7,013,009).

Claim 41 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Chen in view of Addeo in view of Warren and further in view of Gollmar. Claim 48 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Chen in view of Addeo in view of Warren and further in view of Butler. Claim 49 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Chen in view of Addeo in view of Warren in view of Butler and further in view of Nestorovic.

The Applicant respectfully traverses these rejections at least for the reasons previously set forth during prosecution and at least based on the following remarks.

I. REJECTION UNDER 35 U.S.C. § 112

Claims 27-52 stand rejected under 35 U.S.C. 112, second paragraph, for allegedly failing to particularly point out the invention. The claims have been amended to clarify the terms and to further prosecution

The Applicant submits that the rejections under 35 U.S.C. 112 have been addressed, and accordingly, the Applicant requests that the rejection be withdrawn.

II. REJECTION UNDER 35 U.S.C. § 103

A. Requirements For A *Prima Facie* Case Of Obviousness

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure ("MPEP") states the following:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have

been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 **should be made explicit**. The Federal Circuit has stated that "**rejections on obviousness cannot be sustained with mere conclusory statements**"; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."

See MPEP at § 2142, citing *In re Kahn*, 441 F.3d 977, 988, 78 U.S.P.Q.2d 1329, 1336 (Fed. Cir. 2006), and *KSR Int'l Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d at 1396 (quoting Federal Circuit statement with approval) (emphasis added).

Further, as specifically noted in the MPEP, "[t]o establish *prima facie* obviousness of a claimed invention, **all** the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." See MPEP at 2143.03 (emphasis added). Further, "**all words in a claim must be considered** in judging the patentability of that claim against the prior art.' *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA)." See *id.* (emphasis added).

If a *prima facie* case of obviousness is not established, the Applicants are under no obligation to submit evidence of nonobviousness:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. **If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.**

See MPEP at § 2142 (emphasis added).

Additionally, "[i]f the examiner is able to render a claim obvious simply by saying it is so, neither the Board nor [the Federal Circuit] is capable of reviewing that determination. ... If there is neither record evidence nor detailed examiner

reasoning, the Board should not conclude that ... claims are obvious.” *See In re Vaidyanathan*, Appeal 2009-1404 at pages 18-19 (Fed. Cir. May 19, 2010) (nonprecedential).

“[T]he Board cannot simply reach conclusions based on its own understanding or experience – or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to **some concrete evidence in the record in support of these findings**.” *See In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001) (emphasis added).

With those principles in mind, the Applicants now turn to the claim rejections, in particular.

B. Rejection of Independent Claims 27 and 53

With regard to the rejection of independent claim 27 under 35 U.S.C. § 103(a), the Applicant submits that neither Chen, Addeo, nor a combination of Chen and Addeo disclose or suggest at least the limitation of “a control module configured to adjust directional dependence of at least a first directionally dependent microphone of said plurality of directionally dependent microphones based on said one or more voice signals captured by said first directionally dependent microphone and at least a second directionally dependent microphone of said plurality of directionally dependent microphones, wherein said second directionally dependent microphone is located on an ear engaging portion of said eyeglass frame for capturing bodily vibration sound waves,” as recited by the Applicant in amended independent claim 27.

The Applicant submits that Chen teaches an array of microphones across temple bars in an eyeglass hearing aid device, with beam-forming capability in the front-facing microphones to exclude sounds from other directions. Furthermore, the Applicant submits that combining Chen with Addeo or any other microphone references related to capturing bodily vibration sound waves, which is not taught in Addeo, is improper, as this combination teaches away from the objective of Chen, namely a hearing aid device. As indicated by its name, the hearing aid device of Chen is intended to receive audio signals to be amplified and communicated to the user's ears – it is not intended, or desirable, to sense the user's voice itself from captured bodily vibration sounds.

Addeo is cited to merely to show a control module to adjust the position of at least one dynamically dependent microphone. However, this element is not in the amended claim 27. Addeo teaches a controllable microphone array in a teleconference application. Furthermore, Addeo does not overcome the deficiencies of Chen and does not teach or disclose at least “said second directionally dependent microphone is located on an ear engaging portion of said eyeglass frame for capturing bodily vibration sound waves,” as recited by the Applicant in amended independent claim 27.

Accordingly, independent claim 27 is not unpatentable over Chen in view of Addeo and is allowable. Independent claim 53 is similar in many respects to the system disclosed in independent claim 27. Therefore, the Applicant submits that independent claim 53 is also allowable over the references cited in the Office Action at least for the reasons stated above with regard to claim 27.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 27 and 53.

C. Rejection of Dependent Claims 29-34, 37, and 38

Based on at least the foregoing, the Applicant believes the rejection of independent claims 27 and 53 under 35 U.S.C. § 103(a) as being unpatentable over Chen in view of Addeo has been overcome and request that the rejection be withdrawn. Therefore, claims 29-34, 37, and 38 depend from independent claim 27, and are, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 29-34, 37, and 38.

D. Rejection of Dependent Claim 28

Based on at least the foregoing, the Applicant believes the rejection of independent claims 27 and 53 under 35 U.S.C. § 103(a) as being unpatentable over Chen in view of Addeo has been overcome and request that the rejection be withdrawn. Gollmar is cited to for a contact microphone. However, as stated above, the combination of a contact microphone with Chen is inapposite to the objective of Chen as a hearing aid unit, as Chen of course is intended to detect other voices. Therefore, claim 28 depends from independent claim 27, and is, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 28.

E. Rejection of Dependent Claim 35

Based on at least the foregoing, the Applicant believes the rejection of independent claims 27 and 53 under 35 U.S.C. § 103(a) as being unpatentable over Chen in view of Addeo has been overcome and request that the rejection be withdrawn. Butler is cited to for a retinal scanning display. However, Butler does not overcome the deficiencies of Chen and Addeo described above. Therefore, claim 35 depends from independent claim 27, and is, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claim 35.

F. Rejection of Dependent Claim 36

Based on at least the foregoing, the Applicant believes the rejection of independent claims 27 and 35 under 35 U.S.C. § 103(a) as being unpatentable over Chen in view of Addeo and further in view of Butler has been overcome and request that the rejection be withdrawn. Nestorovic is cited to for a detection module that is configured to capture a direction of view. However, Nestorovic does not overcome the deficiencies of Chen, Addeo, and Butler described above. Therefore, claim 36

depends from dependent claim 35 and independent claim 27, and is, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 36.

G. Rejection of Independent Claim 40

With regard to the rejection of independent claim 40 under 35 U.S.C. § 103(a), the Applicant submits that neither Chen, Addeo, Warren nor a combination of Chen, Addeo, and Warren disclose or suggest at least the limitation of “adjusting, via a control module, directional dependence of at least a first directionally dependent microphone of said plurality of directionally dependent microphones based on said one or more voice signals captured by said first directionally dependent microphone and at least a second directionally dependent microphone of said plurality of directionally dependent microphones; wherein said second directionally dependent microphone is positioned for capturing bodily vibration sound waves,” as recited by the Applicant in amended independent claim 40.

As stated previously, Chen teaches an array of microphones across temple bars in an eyeglass hearing aid device, with beam-forming capability in the front-facing microphones to exclude sounds from other directions. Furthermore, the Applicant submits that combining Chen with Addeo, Warren, or any other microphone references related to capturing bodily vibration sound waves, which is not taught in Addeo or Warren, is improper as this combination teaches away from

the objective of Chen, namely a hearing aid device. As indicated by its name, the hearing aid device of Chen is intended to receive audio signals to be amplified and communicated to the user's ears – it is not intended, or desirable, to sense the user's voice itself from captured bodily vibration sounds.

Warren is cited to merely to for wireless communication. However, Warren does not overcome the deficiencies of Chen and Addeo.

Accordingly, independent claim 40 is not unpatentable over Chen in view of Addeo and further in view of Warren and is allowable. The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claim 40.

H. Rejection of Dependent Claims 39, 42-47, and 50-52

Based on at least the foregoing, the Applicant believes the rejection of independent claims 27 and 53 under 35 U.S.C. § 103(a) as being unpatentable over Chen in view of Addeo and claim 40 under 35 U.S.C. § 103(a) as being unpatentable over Chen in view of Addeo and further in view of Warren has been overcome and request that the rejection be withdrawn. Therefore, claims 39, 42-47, and 50-52 depend from independent claims 27 and 40, and are, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 39, 42-47, and 50-52.

I. Rejection of Dependent Claim 41

Based on at least the foregoing, the Applicant believes the rejection of independent claim 40 under 35 U.S.C. § 103(a) as being unpatentable over Chen in view of Addeo and further in view of Warren has been overcome and request that the rejection be withdrawn. Gollmar is cited to for a contact microphone. However, as stated above, the combination of a contact microphone with Chen is inapposite to the objective of Chen as a hearing aid unit, as Chen of course is intended to detect other voices. Therefore, claim 41 depends from independent claim 40, and is, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claim 40.

J. Rejection of Dependent Claim 48

Based on at least the foregoing, the Applicant believes the rejection of independent claim 40 under 35 U.S.C. § 103(a) as being unpatentable over Chen in view of Addeo and further in view of Warren has been overcome and request that the rejection be withdrawn. Butler is cited to for an integrated retinal display. However, Butler does not overcome the deficiencies of Chen, Addeo, and Warren as described above. Therefore, claim 48 depends from independent claim 40, and is, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 48.

K. Rejection of Dependent Claim 49

Based on at least the foregoing, the Applicant believes the rejection of independent claims 40 and 48 under 35 U.S.C. § 103(a) as being unpatentable over Chen in view of Addeo in view of Warren and further in view of Butler has been overcome and request that the rejection be withdrawn. Nestorovic is cited to for a detection module that is configured to capture a direction of view. However, Nestorovic does not overcome the deficiencies of Chen, Addeo, Warren, and Butler as described above. Therefore, claim 49 depends from dependent claim 48 and independent claim 40, and is, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 49.

CONCLUSION

Based on at least the foregoing, the Applicant believes that all claims 27-64 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and request that the Examiner telephone the undersigned Patent Agent at (312) 775-8217.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

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